



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,978	02/16/2001	Kesayoshi Iguchi	PADE: 060	2831

7590 01/30/2004  
PARKHURST & WENDEL, L.L.P.  
1421 Prine Street, Suite 210  
Alexandria, VA 22314-2805

EXAMINER

JASMIN, LYNDIA C

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/783,978

Applicant(s)

IGUCHI ET AL.

Examiner

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-10 and 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1 and 11) in Paper No. 9 is acknowledged. Claims 2-10 and 12-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
2. The traversal is on the ground(s) that the search and examination of claims (1-20) could be made without serious burden.

The examiner disagrees. Applicants have not traversed on the ground that the species are not patentably distinct. Furthermore, it is noted that "a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search" (MPEP 803). Regarding the distinct inventions, the examiner has shown by appropriate explanation separate status in the art.

Also, the diverse species have a separate status in the art (separate inventive effort).

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 101***

3. Claims 1 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 and 11 only recite an abstract idea. The recited steps of merely recording an order on a slip and reading the slip using a reader does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to take an order on a slip.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention involves customer service (i.e., repeatable) used in ordering commodity and accepting the order at an order window (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1 and 11 are deemed to be directed to non-statutory subject matter.

***Drawings***

4. Figures 28-30 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Objections***

5. Claims 1 and 11 are objected to because of the following informalities: In claims 1 and 11, at line 4, the term "recoding" is misspelled. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iguchi et al. (5,589,676), in view of Withrow (6,116,505). Iguchi et al. discloses an order-taking method with the steps of: taking an order from each customer in advance, recording the order on a slip, and then handing the slip to the customer (col. 2, lines 12-17), passing the slip (30, having an order

Art Unit: 3627

number) from the customer to the operator (which inputs the order number), and entering it into a register, (via an account key on a slave register) thereby identifying the customer at the order window with order contents as illustrated in figs. 5 and 6. Iguchi et al. further discloses the accounting system can be employed in a drive-through restaurant (which inherently will refer to an order window). However Iguchi et al. fails to explicitly disclose using a reader to read the slip.

Withrow discloses the concept of dispensing a printed code or other indicia, which then scanned to effect purchase of a customer's product. From this teaching of Withrow, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the order taking of Iguchi et al. to include the scanner reading indicia printed at the dispenser as taught by Withrow in order to allow a control system to associate a customer and products with a fueling authorization.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Acosta (4,733,754), Fuyama et al. (4,843,547), Iguchi et al. (5,864,824), Elliott (6,366,220 B1), and Ramachandran et al. (6,386,323 B1) are cited for disclosing ordering taking in a drive-through environment.

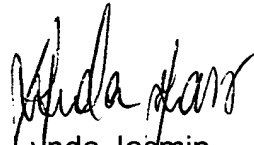
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is

Art Unit: 3627

(703) 305-0465. The examiner can normally be reached on Monday- Friday  
(8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183.  
The fax phone number for the organization where this application or proceeding  
is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application  
or proceeding should be directed to the receptionist whose telephone number is  
308-1113.

  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627

1/23/04

lj